

REMARKS

Claims 1-54 are presently pending.

Rejections under 35 U.S.C. § 103

Independent claims 1, 22, 33, and 34 stand rejected under §103(a) as being unpatentable over the combination of U.S. Patent 6,449,344 to Goldfinger et al. ("Goldfinger") and U.S. Patent 6,389,127 to Vardi et al. ("Vardi"). Dependent claims 2-21, 23-32, and 35-54 stand rejected under §103(a) as being unpatentable over various combinations of Goldfinger, Valdi, and U.S. Patent No. 5,848,134 to Sekiguchi et al. ("Sekiguchi"). Applicant respectfully traverses these rejections, and reconsideration of Applicant's pending claims is respectfully requested.

1. **Hypothetical Combination does not Achieve Claimed Subject Matter.**

As the PTO provides in MPEP §2143, “[t]o establish a prima facie case of obviousness, . . . the prior art reference (or references when combined) must teach or suggest all the claim limitations.” Furthermore, under MPEP §2142, “[i]f the examiner does not produce a prima facie case, the applicant is under no obligation to submit evidence of nonobviousness.” It is submitted that the Office action does not factually support a prima facie case of obviousness based on the cited references for the following reasons.

Claim 33 recites identifying a subscriber, a telephone number at which they can receive messages, and a period of time for which they can receive messages at this number; establishing the user's presence and ability to receive instant messages on the data network during the specified time period; where an instant message is sent to the subscriber during this period of availability, calling the subscriber at the predetermined telephone number and delivering the message.

Neither Goldfinger nor Valdi, alone or in combination, teach or suggest identifying a period of time for which they can receive messages at a number or establishing the user's presence and ability to receive instant messages on the data network during the specified time period, as is recited in claim 33. The Office action

relies on col. 6, lines 32-51 of Goldfinger when addressing this limitation. However, the cited text of Goldfinger describes "a user 34 establishing a connection to communications network 14 preferably in the same manner as described for user 18 in FIG. 1. Once user 34 is connected, information management apparatus 28 checks the list of sought users to determine if user 34 is sought by user 18. If so, information management apparatus 28 then checks the list of connected users to determine if user 18 is still connected. If user 18 is still connected, information management apparatus 28 causes annunciator 24 to transmit an annunciation to user 18, wherein the annunciation typically includes the unique identification code for sought user 34, the current network address for sought user 34, and preferably other information provided by user 18. Information management apparatus 28 preferably also checks the list of sought users to determine if user 18 is sought by user 34 and, if so, causes annunciator 24 to transmit an annunciation to user 34 as described above."

Accordingly, the cited text of Goldfinger discloses simply "check[ing] the list of connected users to determine if user 18 is still connected," and fails to teach or suggest claim 33's recitation of "identifying ... a period of time for which they can receive messages at this number." Likewise, Applicant can find no teaching or suggesting in the cited text of Valdi of identifying a period of time for which a user can receive messages at a number. Therefore, the hypothetical combination of the cited references would not achieve applicant's claimed invention. Accordingly, the combined art fails to meet the standard presented by MPEP § 2143, which requires that the cited references must teach or suggest all the claim limitations to establish a *prima facie* case of obviousness. Therefore, claim 33 is deemed allowable for at least this reason.

Claim 34 recites a similar limitation and is allowable for at least the same reason as stated above with respect to claim 33. Claims 35-54 depend from and further limit claim 34 and are allowable for at least this reason.

2. No Basis in Cited References for Combining References and so Rejection is Properly Withdrawn.

In view of the above, Applicant further respectfully submits that the combination of Goldfinger and Valdi is improper and cannot be used to reject independent claims 1,

22, 33, and 34. MPEP § 2143.01 states that “[o]bviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art.... The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” Furthermore, according to MPEP §2143, “[t]he teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant’s disclosure. *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991). Goldfinger and Valdi are directed to solving separate problems (as described previously), and there is no teaching, suggestion, or motivation to support the combination of Goldfinger and Valdi.

Furthermore, rejection cannot be predicated on the mere identification of individual components of claimed limitations. Rather, particular findings must be made as to the reason the skilled artisan, with no knowledge of the claimed invention, would have selected these components for combination in the manner claimed. *Ecolochem Inc. v. Southern California Edison*, 56 USPQ2d 1065, 1076 (Fed. Cir. 2000).

The case law recites that the best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for a showing of a teaching or motivation to combine the cited references. See *Dembiczak*, 50 USPQ2d, 1614, 1617 (Fed. Cir. 1999). “Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor’s disclosure as a blueprint for piecing together the prior art to defeat patentability – the essence of hindsight.” *Id.* It is respectfully submitted that the only way Goldfinger and Valdi could be pieced together to defeat patentability is indeed to use Applicant’s disclosure as a blueprint.

Accordingly, Applicant submits that independent claims 1, 22, 33, and 34 are allowable. Claims 2-21, 23-32, and 35-54 depend from and further limit their respective independent claim and are allowable over the cited references for at least this reason.

Conclusion

It is respectfully submitted that independent claims 1, 22, 33, and 34 are in condition for allowance. Dependent claims 2-21, 23-32, and 35-54 depend from and further limit their respective independent claims and therefore are allowable as well.

Should the Examiner deem that any further amendment is desirable to place this application in condition for allowance, the Examiner is invited to telephone the undersigned at the below listed telephone number.

Respectfully submitted,

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